

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed June 13, 2008. Through this response, claim 7 has been amended to correct for proper antecedent basis, and claims 62 and 63 have been added. Reconsideration and allowance of the application and pending claims 1, 3, 7, 10-39, 62, and 63 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 1, 3, 7 and 10-39

Claims 1, 3, 7 and 10-39 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hartman et al.* ("Hartman," U.S. Pat. No. 5,960,411) in view of *Jacobi et al.* ("Jacobi," U.S. Pat. No. 6,064,980). Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

The M.P.E.P. § 2100-116 states:

Office policy is to follow *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. 103. . . the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

In the present case, it is respectfully submitted that a *prima facie* case for obviousness is not established using the cited art of record.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. A method in a media service system for transaction configuration, the method comprising the steps of:

enabling by an administrator of at least one selection by a user of at least one transaction configuration option from among a plurality of transaction configuration options presented to the user by the administrator, wherein each transaction configuration option defines one or more actions that take place during the purchase of an item or service when the user utilizes at least one client device to complete a purchase; and

implementing at least one transaction process responsive to the user indicating a desire to purchase an item or service utilizing the at least one client device from among a plurality of transaction processes comprising pre-configured transaction processes and user defined transaction processes, wherein at least one user defined transaction process comprises the user selected at least one transaction configuration option,

wherein at least one transaction configuration option comprises a single execution transaction option that enables the user to initiate and complete an entire purchase in one execution.

Applicants respectfully submit that a *prima facie* case for obviousness is not established using *Hartman* in view of *Jacobi*. The non-final Office Action (page 3) acknowledges that “Hartman does not teach that the configuration options are presented to the user by the administrator.” However, the non-final Office Action (pages 3-4) alleges the following with regard to *Jacob* (emphasis added):

However, *Jacobi* teaches that a system administrator can control services in a computer network for e-commerce (claims 6, 13, and 20). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teaching of *Jacobi* into the invention of *Hartman*. One of ordinary skill in the art would have been motivated to do so in order to allow the system administrator to exert some control over the system and applications of Hartman.

Applicants respectfully disagree. The non-final Office Action appears to use the rationale described in MPEP 2143 (G), which provides the following guidelines (emphasis added):

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that "a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success." *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. "[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the 'improvement' is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical-we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references." *Id.* at 1368, 80 USPQ2d at 1651.<

Addressing (1) above, Applicants note that no evidence has been presented that there is some teaching in the cited art of record or knowledge generally available to one having ordinary skill that there is some teaching, motivation, or suggestion to allow the system administrator to exert some control over the system and applications of Hartman as alleged

in the non-final Office Action, as pertaining to a ***transaction configuration option*** that ***defines one or more actions that take place during the purchase of an item or service when the user utilizes at least one client device to complete a purchase.***

Indeed, *Jacobi* is directed to collaborative filtering techniques (see, Abstract, *Jacobi*) that are involved with user ratings of items or services and the subsequent generation of recommendations (see, col. 2, lines 17-33, *Jacobi*), and not to “transaction configuration options.” A thorough review of the entirety of *Hartman* reveals, assuming *arguendo* the disclosure of single-action ordering, an automated process with no suggestion or teaching of administrator involvement. As set forth in MPEP 2142 and well-established Federal case law (emphasis added):

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicants respectfully submit that at least since a proper motivation is not evidenced in the cited art of record, but rather improperly gleaned exclusively from Applicants' disclosure, the proposed combination of *Hartman* and *Jacobi* fails to support a *prima facie* case of obviousness, and hence Applicants respectfully request that the rejection be withdrawn.

Additionally, with regard to (2) from MPEP 2143 (G), no reasonable expectation of success is alleged, nor can it be reasonably alleged in view of the absence of any teaching or suggestion of “administrator” involvement in ***enabling*** of a ***transaction configuration***

option as claimed. For this additional reason, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and hence respectfully request that the rejection be withdrawn.

Because independent claim 1 is allowable over *Hartman* in view of *Jacobi*, dependent claims 3, 7, and 10-39 are allowable as a matter of law for at least the reason that the dependent claims 3, 7, and 10-39 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In addition, Applicants respectfully submit that one or more of the dependent claims are allowable on distinct and separate grounds, and hence the rejections should be withdrawn. For instance, with regard to claim 7, *Hartman* in view of *Jacobi* fails to disclose, teach, or suggest “wherein the user is enabled to make at least one selection of a plurality of particular transaction configuration options included in at least one pre-configured transaction process, the at least one selection causing at least one plurality of particular transaction configuration options to be removed from the pre-configured transaction process.”

As another example, Applicants respectfully submit that *Hartman* in view of *Jacobi* fails to disclose, teach, or suggest at least “wherein the at least one transaction configuration option is a PIN option and wherein the implementing step implements the transaction process responsive to at least one selection of the PIN option requiring a correct PIN entry to complete a transaction.”

Absent allowance of the claims in the next response, Applicants appreciate it if any future rejections address each claim and corresponding elements as required under 37 CFR 1.104.

In summary, it is Applicants’ position that a *prima facie* for obviousness has not been made against Applicants’ claims. Therefore, it is respectfully submitted that each of

these claims is patentable over *Hartman* in view of *Jacobi* and that the rejection of these claims should be withdrawn.

II. New Claims

As identified above, claims 62 and 63 have been added into the application through this response, consistent with the restriction to Group I (transaction method) claims. Applicants respectfully submit that these new claims are allowable for at least the reason that *Hartman* in view of *Jacobi* fails to disclose, teach, or suggest at least “***providing a first graphics user interface (GUI) screen to an administrator that presents plural options associated with rental of video content, the plural options including a how to bill option, a reminder option, and a personal identification number (PIN) option.***” Further, *Hartman* in view of *Jacobi* fails to disclose, teach, or suggest at least “***providing a first graphics user interface (GUI) screen to an administrator that presents plural options associated with steps in a transaction process associated with a rental of video content.***”

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/dr/

David Rodack
Registration No. 47,034

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1500
600 Galleria Parkway
Atlanta, Georgia 30339
(770) 933-9500